

REMARKS / ARGUMENTS

This Amendment is submitted in full response to the Office Action dated March 5, 2007, wherein claims 1-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,014,650 issued to Zampese ("Zampese") in view of U.S. Publication No. 2002/0152158 to Paleiov ("Paleiov"). In addition, claims 1-26 stand rejected on the ground of non-statutory double patenting over claims 1-16 of U.S. Patent No. 6,324,526 issued to Applicant. Finally, claims 1-26 are also provisionally rejected on the ground of non-statutory double patenting over claims 1, 27-29, 33, 35, and 36 of Applicant's co-pending application No. 11/252,009.

An appropriate Request for an Extension of Time and the corresponding fee are being filed concurrently herewith, and accordingly, Applicant respectfully requests reconsideration of this application in view of the foregoing amendments and the following remarks. Applicant also notes that an IDS is being submitted concurrently with the present response for the Examiner's consideration.

Furthermore, Applicant presents herein currently amended claims 1 and 18, original dependent claims 2-17 and 19-26, and

new independent claims 27 and 28, which are all believed to be in condition for immediate allowance.

A. Priority.

As an initial matter, Applicant notes that there are several conditions that must be met for a later-filed application to receive the benefit of the prior filed application, namely, (1) the prior filed application must disclose the claimed invention of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. §112, (2) the later-filed application must be co-pending with the prior-filed application, (3) the later-filed application must contain a reference to the prior-filed application, and (4) the later-filed application must be filed by an inventor or inventors named in the prior-filed application. MPEP §201.11. As will be apparent from the following remarks, and in light of the amendments to the claims made herein, the claimed invention of the present Application has met each of the above-mentioned conditions such that it should now receive the benefit of the filing date of the prior filed Application on **January 15, 1999.**

Specifically, as presented in the original specification of the currently pending Application, and acknowledged in the above-referenced outstanding Office Action, this application is a continuation-in-part patent application of previously filed, application having Serial No. 09/231,745, filed on January 15, 1999 ("Parent Application"), now patented as U.S. Patent No. 6,324,526 ("the '526 patent") (Applicant points out in the spirit of full disclosure that as referenced in the IDS, the '526 patent is presently undergoing re-examination, however, it is believed that that proceeding does not in any way impact the priority claims being discussed herein). In the outstanding Office Action, the U.S. Patent and Trademark Office ("PTO") has stated that:

[t]his application relates to secure purchases for pre-established account[s] where claims are broader than its parent application (credit card purchases only) is not supported by the parent application. The effective filing date of this application is, therefore, effective date of the child CIP, 11/09/2001. (Office Action, p.2).

Although Applicant believes that the original claims as presented in this Application are supported by the specification of the Parent Application, independent claims 1 and 18 have been amended herein to relate to "secure *credit card* purchases" such

that the claimed invention is now clearly supported and disclosed in the manner provided by the first paragraph of 35 U.S.C. §112 in both the specification of the currently pending Application, filed on November 9, 2001, and the Parent Application, filed on January 15, 1999. Furthermore, dependent claims 2-17, and 18-26 being dependent either directly or indirectly from independent claims 1 and 18, respectively, are also supported and disclosed in the Parent Application as required by 35 U.S.C. §112, ¶1. In particular, as support for the method of performing "secure credit card purchases" for a customer's "pre-established credit card account" as presented in currently amended independent claim 1, the "secure credit card purchase" verification system of currently amended claim 18, and dependent claims 2-17 and 19-26 being dependent either directly or indirectly therefrom, Applicant respectfully directs the PTO's attention to the Parent Application at least at page 6, lines 11-16; page 9, line 20 - page 10, line 1; page 11, lines 23-25; page 12, line 22 - page 13, line 13; and Figure 1 (see also, the '526 patent, col. 3, lines 7-37; col. 5, lines 17-19; col. 5, lines 42-58; and Figure 1), and the currently pending continuation-in-part patent Application at least at page 1,

lines 9-22; page 12, lines 6-10; and Figure 1.

In addition, newly presented independent claims 27 and 28 are also supported in the manner provided by 35 U.S.C. §112, ¶1 in both the specification of the currently pending Application, filed on November 9, 2001, and the Parent Application, filed on January 15, 1999. Specifically, rather than being directed to "secure *credit card* purchases," as in independent claims 1 and 18, claims 27 and 28 are directed to "secure *debit card* purchases." In all other respects, however, independent claims 1 and 18 are identical to independent claims 27 and 28, respectively. Furthermore, as support for newly presented independent claims 27 and 28, as presented herein, Applicant respectfully directs the PTO's attention to at least page 6, lines 11-16 of the originally filed Parent Application (see also the '526 patent, col. 3, lines 7-12, and col. 3, lines 24-37) and the currently pending continuation-in-part patent Application at page 1, lines 9-22; page 12, lines 6-10; and page 13, lines 11-17.

In addition, the remaining requirements for the currently pending continuation-in-part Application to obtain the benefit of the filing date of the Parent Application are indeed

satisfied. Specifically, the currently pending application was filed on November 9, 2001, which is prior to the issue date of the '526 patent, thereby obtaining co-pendency therebetween. Furthermore, as above, the currently pending application contains a reference to the prior filed Parent Application, both of which were filed in the name of the exact same inventor, namely, John D'Agostino.

As such, currently amended independent claims 1 and 18, original dependent claims 2-17 and 19-26, and new independent claims 27 and 28 are each supported by the specification of the Parent Application filed on January 15, 1999, such that each claim is believed to benefit from said filing date.

B. Rejections Under 35 U.S.C. §103(a).

As above, claims 1-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Zampese, filed on August 19, 1997, in view of Paleiov, filed on April 12, 2001. In light of the foregoing amendments to the claims and remarks thereto, Applicant respectfully notes that claims 1-28, as presented herein, are believed to benefit from the filing date of the Parent Application, namely, January 15, 1999, which pre-dates

the cited reference to Paleiov, thereby rendering the rejections directed to the combination of Zampese in view of Paleiov moot and overcome.

C. Terminal Disclaimer.

In addition, two properly executed terminal disclaimers are being filed contemporaneously herewith, thereby eliminating Applicant's U.S. Patent No. 6,324,526 and Applicant's co-pending Application No. 11/252,009 as a basis for the rejection of the claims herein.

D. Conclusion.

Based on the foregoing remarks and the above amendments to the claims it is respectfully requested that this application be given full and favorable reconsideration. It is believed that upon doing so, this application will be deemed to be in condition for immediate allowance, which action is now respectfully requested.

In addition, a request for an appropriate extension of time is enclosed herewith along with the corresponding PTO fee. In the event that any additional fee may be required by the filing

Application No. 10/037,007
Amdt. dated September 5, 2007
Reply to Office Action dated March 5, 2007

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of this paper, the Commissioner is hereby authorized to charge
any fees and/or credits to our **Deposit Account No. 13-1227.**

Respectfully Submitted,

MALLOY & MALLOY, P.A.
Attorneys for Applicant
2800 S.W. 3rd Avenue
Historic Coral Way
Miami, Florida 33129
(305)858-8000

By: 

Peter A. Matos
Reg. No. 37,884

Date: 9/5/07